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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,142	02/19/2002	Juan Amengual	47133.010100	6466
54353 7590 08/23/2007 MANUEL VALCACEL c/o GREENBERG TRAURIG, P.A. 1221 BRICKELL AVENUE MIAMI, FL 33131			EXAMINER ARAQUE JR, GERARDO	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/078,142	AMENGUAL ET AL.	
	Examiner	Art Unit	
	Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 27-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 27 – 80 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 27 – 80 are directed to advertising methods, which were not originally presented prior to the Office Action sent on March 7, 2006.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27 – 80 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1 – 26** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. **Claims 1 – 26** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: means for inputting customizable criteria or the introduction of customizable criteria.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1 – 12 and 14 – 26** are rejected under 35 U.S.C. 102(e) as being anticipated by **Spear et al. (US Patent 6,853,621 B1)**.

8. In regards to **claim 1**, **Spear** discloses a customizable computerized system for providing access to specified Internet websites and comparable alternative websites utilizing telephone numbers as search queries, comprising:

means for receiving a system user search query for a specified Internet website in the form of a telephone number corresponding to said website's proprietor (**Col. 2 – 3 Lines 45 – 7; Column 24 Lines 42 – 50**);

means for processing said user search query to provide access to said specified Internet website in response to said query (**Column 4 Lines 41 – 43**);

means for providing a referential directory of additional Internet websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison (**Col. 2 – 3 Lines 58 – 7**); and

means for providing access to additional Internet websites displayed in said referential directory (**Col. 2 – 3 Lines 58 – 7**).

9. In regards to **claim 2**, **Spear** discloses means for processing changes to Internet website addresses such that access to said websites is provided in response to user queries using either a prior address or a changed address (**Column 3 Lines 41 – 46; Col. 14 Lines 31 – 32**).

10. In regards to **claim 3**, **Spear** discloses means for displaying to users content from said Internet websites in a standardized format (**Column 4 Lines 3 – 7**).

11. In regards to **claim 4**, **Spear** discloses wherein said customizable criteria are provided by electronic communication from said user (**Column 23 Lines 8 – 10**).

12. In regards to **claim 5**, **Spear** discloses wherein said customizable criteria are preprogrammed into said system (**Column 9 Lines 62 – 63, wherein in order for the customizable criteria to be preprogrammed into the system the GUI had to be programmed**).

13. In regards to **claim 6**, **Spear** discloses wherein said means for providing a referential directory of additional Internet websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison comprises (**Column 24 Lines 50 – 53; Column 25 Lines 8 – 10**)

one or more databases containing data regarding characteristics of a plurality of Internet websites and one or more software applications that select said additional websites based on comparison of data pertaining to said specified website and data pertaining to said additional websites (**Column 25 Lines 7 – 9**).

14. In regards to **claim 7**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the geographic location of the proprietors of the websites being compared (**Column 18 Lines 44 – 47; Column 25 Lines 7 – 10**).

15. In regards to **claim 8**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the products or services offered by the websites being compared (**Column 23 Lines 34 – 36**).

16. In regards to **claim 9**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the prices for products or services offered by the websites being compared (**Column 24 Lines 51 – 52, 60 – 63**).

17. In regards to **claim 10**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the type of content provided by the websites being compared (**Column 25 Lines 28 – 31**).

18. In regards to **claim 11**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding

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the date of publication of content provided by the websites being compared (**Column 14 Lines 23 – 32**).

19. In regards to **claim 12**, **Spear** discloses

means for receiving a system user search query for a specified electronic mail recipient in the form of a telephone number corresponding to said recipient (**Column 26 Lines 1 – 3**);

means for processing said user search query to provide information pertaining to said recipient (**Column 3 Lines 41 – 46; Column 7 – 9**); and

means for sending electronic mail to said recipient (**Column 26 Lines 1 – 13**).

20. In regards to **claim 14**, **Spear** discloses a method for providing access to specified Internet websites and a referential directory of additional websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison utilizing telephone numbers as search queries, comprising the following steps:

receiving a system user search query for a specified Internet website in the form of a telephone number corresponding to said website's proprietor (**Col. 2 – 3 Lines 45 – 7; Column 24 Lines 42 – 50**);

processing said user search query to provide access to said specified Internet website and a referential directory of additional websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison, in response to said query (**Col. 2 – 3 Lines 58 – 7**); and

providing access to said additional Internet websites (**Col. 2 – 3 Lines 58 – 7**).

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21. In regards to **claim 15**, **Spear** discloses a customizable computerized system for providing access to specified Internet websites and comparable alternative websites, comprising:

means for receiving a system user search query for a specified Internet website, wherein said user search query is in the form of the telephone number for the proprietor of said specified Internet website; ((Col. 2 – 3 Lines 45 – 7; Column 24 Lines 42 – 50);

means for processing said user search query to provide access to said specified Internet website in response to said query and a referential directory of additional websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison (Col. 2 – 3 Lines 58 – 7; Column 4 Lines 41 – 43); and

means for providing access to said additional Internet websites (Col. 2 – 3 Lines 58 – 7).

22. In regards to **claim 16**, **Spear** discloses wherein search user query is in the form of a Domain Name (Column 11 Lines 39 – 44).

23. In regards to **claim 17**, **Spear** discloses means for processing changes to Internet website addresses such that access to said websites is provided in response to user queries using either a prior address or a changed address (Column 3 Lines 41 – 46).

24. In regards to **claim 18**, **Spear** discloses means for displaying to users content from said Internet websites in a standardized format (Column 4 Lines 3 – 7).

25. In regards to **claim 19**, **Spear** discloses wherein said customizable criteria are provided by electronic communication from said user (**Column 23 Lines 8 – 10**).

26. In regards to **claim 20**, **Spear** discloses wherein said customizable criteria are preprogrammed into said system (**Column 9 Lines 62 – 63, wherein in order for the customizable criteria to be preprogrammed into the system the GUI had to be programmed**).

27. In regards to **claim 21**, **Spear** discloses wherein said means for providing said referential directory of additional websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison comprises (**Column 24 Lines 50 – 53; Column 25 Lines 8 – 10**)

one or more databases containing data regarding characteristics of a plurality of Internet websites and one or more software applications that select said additional websites based on comparison of data pertaining to said specified website and data pertaining to said additional websites (**Column 25 Lines 7 – 9**).

28. In regards to **claim 22**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the geographic location of the proprietors of the websites being compared (**Column 18 Lines 44 – 47; Column 25 Lines 7 – 10**).

29. In regards to **claim 23**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the products or services offered by the websites being compared (**Column 23 Lines 34 – 36**).

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30. In regards to **claim 24**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the prices for products or services offered by the websites being compared (**Column 24 Lines 51 – 52, 60 – 63**).

31. In regards to **claim 25**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the type of content provided by the websites being compared (**Column 14 Lines 23 – 32**).

32. In regards to **claim 26**, **Spear** discloses wherein said one or more software applications select additional websites based on comparison of information regarding the date of publication of content provided by the websites being compared (**Column 14 Lines 23 – 32**).

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. **Claims 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Spear et al. (US Patent 6,853,621 B1)**.

35. In regards to **claim 13**, **Spear** discloses wherein said means for sending electronic mail to said recipient further comprises means for sending said electronic mail to multiple alternate electronic mail addresses corresponding to said recipient, said

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alternate electronic mail addresses being selected based on customizable criteria

(Column 26 Lines 1 – 13, Moreover it is old and well known that an individual can have more than one e-mail address and that it would have been obvious to one skilled in the art that one would have multiple e-mail addresses for various online subscriptions for organization or having dedicated e-mail addresses for each subscription).

Response to Arguments

36. Applicant's arguments filed 5/15/07 have been fully considered but they are not persuasive.

35 USC 112, second paragraph

37. Rejection toward "comparable alternative" has been withdrawn.

38. Applicant argues that the essential step of inputting customizable criteria is "not critical, and frankly, is not part of the system." However, the Examiner asserts that the necessary step to indicate that customizable criteria have been entered in claim 1 is essential because the invention is based on the customizable criteria, such as the referential directory. Applicant also argues that the rejection is not proper because it should be made under 35 USC 112, first paragraph. However, the issue that was raised had nothing to do with enablement, but with indefiniteness. A step indicating that customizable criteria was inputted is needed in order to better understand that, for example, the referential directory is based on this critical information.

Rejection under 35 USC 102

39. Applicant argues that Spear fails to disclose or suggest, "a system whereby a user can access a specified website and comparable alternative websites utilizing the telephone number of the proprietor of the specified website as search queries comprising means for receiving a system user search query for a specified Internet website in the form of a telephone number corresponding to said website's proprietor," as well as, "means for processing said user search query to provide said specified Internet website in response to said query." However, as discussed above, Spear discloses that a telephone number is inputted into a query field and information corresponding to the telephone number is displayed to the user, such as a listing of service providers. Moreover, the server as disclosed by Spear also discloses that it forwards the user to a website

40. Applicant further argues that Spear does not disclose a feature of updating a change of a website address or change in corresponding phone number. The Examiner has further cited within Spear to disclose the feature of updating. Moreover, it is old and well known that any changes made to a website are reflected whenever the page is updated and any new links provided are also displayed on the website.

41. Applicant further argues that there is not mention of displaying the website content in a standardized format. However, it is old and well known that several standardized formats are used when creating a website and that one having ordinary skill in the art would have known which to use.

42. Applicant further argues that the Examiner has added wording desired for the rejection on the Examiner's own assumption. However, the Examiner asserts that the

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additional wording used was meant to clarify the cited section of Spear and why the citation was used.

43. Applicant further argues that a hyperlink to a web page is not a database containing data. However, the Examiner asserts that Spear discloses that the service provider attribute information is provided via a hyperlink to the service provider's web page. As a result, the webpage displayed inherently contains data.

44. Applicant further argues that Spear does not disclose a comparison based on customizable criteria to generate the list of telephone service providers. However, the listing provided by Spear is based on the information entered by the user, which can be changed from user to user, for example.

45. In regard to the arguments toward claim 13, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007)(citing KSR, 82 USPQ2d at 1396)(available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Conclusion

46. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

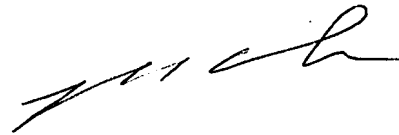
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A handwritten signature in black ink, appearing to read "Smith".

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